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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,556	09/12/2003	Arun Kumar Sinha	056859-0189	6407
22428	7590	03/19/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			KEYS, ROSALYND ANN	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,556

Applicant(s)

SINHA ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 23-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/12/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Status of Claims

1. Claims 23-35 are pending.
Claims 1-22 are cancelled.
Claims 23-35 are rejected.

Information Disclosure Statement

2. The information disclosure statement filed September 12, 2003 has been considered.

Specification

3. The abstract of the disclosure is objected to because the nomenclature for the compound (NEOLASA-I) is incorrect, i.e., one of the 1-(2', 4', 5'-trimethoxy) phenyl groups should be deleted. Correction is required. See MPEP § 608.01(b).
4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:
 - 1) In step (a) of claim 23 there is no support for the limitation "organic solvent". The specification only provides support for "acetic acid".
 - 2) In step (e) of claim 23 there is no support for the limitation "aliphatic halogenated hydrocarbon". The specification only provides support for "dichloromethane".

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3) In claim 24 there is no support for the limitation "propionic acid". The specification only provides support for "acetic acid".

4) In claim 27 there is no support for the limitations "carbon tetrachloride" and "chloroform". The specification only provides support for "dichloromethane".

5) In claim 31 there is no support for the limitation "organic solvents". The specification only provides support for "hexane".

5. The disclosure is objected to because of the following informalities: The specification contains many typographical errors, such as N"EONLASA II" on page 1, line 16 and page 16, line 10; "harmone" blocking on page 2, line 4; and "till" on page 18, line 21. The Examiner requests that the Applicant review the specification and correct all such errors. Further, on page 12, lines 25 and 26 of the specification, the Applicants make reference to US Patent No. 09-805,832 and US Patent No. 09-823,123. The text "US Patent No." should be deleted because 09-805,832 and 09-823,123 are US Patent Applications not US Patents.

Appropriate correction is required.

Claim Objections

6. Claim 1 is objected to because of the following informalities: the compound name 1-(2, 4, 5-teimehtoxy)phenyl-1-propanone) is a misspelling the compound 1-(2, 4, 5-trimethoxy)phenyl-1-propanone). Also an "a" should be placed in front of the word neolignan in line 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 23-35 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step of hydrogenating toxic β -asarone or calamus oil containing a mixture of α , β , and γ -asarone to obtain 2, 4, 5-trimethoxyphenylpropane of formula I (see paragraph bridging pages 9 and 10).

9. Claim 27 recites the limitation "halogenated hydrocarbon in (d) is dichloromethane, carbon tetrachloride or chloroform" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. The halogenated hydrocarbon limitation does not appear until step (e).

10. Claim 28 recites the limitation "halogenated hydrocarbon in (d) is dichloromethane " in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. The halogenated hydrocarbon limitation does not appear until step (e).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sinha et al. (US 6,590,127 B1).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynn Keys whose telephone number is 571-272-

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0639. The examiner can normally be reached on M and F 3:00-8:00 pm and T-R 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalind Keys
Primary Examiner
Art Unit 1621

March 16, 2004